

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of *a posteriori* unity of invention may only be established by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Furthermore, unity of invention only needs to be determined in the first place between independent claims and not the dependent claims, as stated in 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

The instant application contains only two independent claims, claim 1 and claim 2. Claims 3, 5, 7, 9, 11, 13, 15, 17, and 19 variously depend from claim 1, as each of those claims contains all the features of claim 1 and contains a reference, to either claim 1 or an intervening claim, and then states the additional features claimed. Likewise, claims 4, 6, 8, 10, 12, 14, 16, 18, and 20 variously and properly depend from claim 2. Additionally, independent claims 1 and 2 share all the same subject matter with the exception that the process of claim 1 is carried out in an organic solvent, whereas the process of claim 2 is carried out in a supercritical fluid.

Accordingly, all the claims share common subject matter and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 1 and 2 is known in the prior art. Therefore, Applicant respectfully submits that lack of unity of invention has not been established, and thus a restriction requirement based on a lack of unity of invention is improper.

Moreover, the Office Action has applied the wrong standard in requiring an election between species. Although unity of invention practice under PCT Rule 13 recognizes that alternate forms of an invention may be present in separate independent claims, or in a single claim, restriction between distinct embodiments of a single claim may only be required if there is a lack of unity of invention in that claim, or, in other words, the distinct embodiments share no common subject matter that defines a contribution over the prior art. *See* ISPE 10.09; MPEP §1250(II). The "patentably distinct species" standard, as applied under U.S. restriction practice, is not applicable to the current claims. Furthermore, the Office Action

fails to establish that the "patentably distinct species" lack *a posteriori* unity of invention.

Accordingly, the election of species requirement is improper and must be withdrawn.

Reconsideration and withdrawal of the restriction and election of species requirement are respectfully requested.

Respectfully submitted,



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